

## **REMARKS**

Applicant respectfully requests reconsideration and allowance of all of the claims of the application. The status of the claims is as follows:

- Claims 27-37 were pending at the time of the action.
- Claims 27-36 are amended herein.
- New claims 64-112 are presented herein.
- Claims 27-37 and 64-112 are presented for examination.

Support for the amendments to claims 27-36 is found in the specification, as originally filed, at least at paragraphs [00154]-[00157]. The amendments are submitted herein to address the rejections under 35 U.S.C. § 101. Support for the new claims is found in the specification and claims as originally filed. These amendments and new claims do not alter the previously searched scope of the claims, nor do these amendments and new claims introduce any new matter.

### **Provisional Obviousness-Type Double Patenting Rejection**

Claim 27 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being obvious over claim 1 of pending U.S. Patent Application No. 12/098,971.

Applicant respectfully traverses this rejection. U.S. Patent Application No. 12/098,971 is a divisional application which claims priority to the current application. U.S. Patent Application No. 12/098,971 was filed in response to a Restriction Requirement mailed January 25, 2008 in the current application. Applicant respectfully submits that, according to MPEP 804.01, which references 35 U.S.C. 121, if the Office

maintains that the previously issued Restriction Requirement was proper, then the obvious-type double patenting rejection is improper.

Accordingly, Applicant respectfully requests that this rejection be withdrawn. If the Office maintains the provisional obviousness-type double patenting rejection, then Applicant respectfully requests that the Office hold this rejection in abeyance until this application is otherwise in condition for allowance.

### **Claim 37 Complies With § 112, 2nd Paragraph**

Claim 37 stands rejected under 35 U.S.C. § 112, Paragraph 2, as allegedly being indefinite. Applicant respectfully traverses this rejection.

In rejecting claim 37, the Office contends:

It recites the language “means for” without a clearly defined corresponding structure from the specification. In other words, one of ordinary skill in the art would not be able to precisely identify the associated structure, material, or acts necessary for achieving the specified function within the specification.” *Office Action*, pages 5-6.

Applicant respectfully disagrees. For example, Applicant submits that Fig. 14 and the corresponding description found at least in paragraphs [00142]-[00152] identifies an example structure that corresponds with the “means” recited in claim 37. For example, the claimed “means for receiving...a bookmark” may correspond to the “network interface” shown in Fig. 14 and described at least in paragraph [00147]; the claimed “means for presenting a UI...” may correspond to the audio/video output shown in Fig. 14 and described at least in paragraph [00149]; the claimed “means for receiving

user input...” may correspond to the input interface shown in Fig. 14 and described at least in paragraph [00147]; the claimed “means for requesting...” may correspond to the resume module shown in Fig. 14 and described at least in paragraph [00150]; and the claimed “means for presenting the multimedia program” may also correspond to the audio/video output shown in Fig. 14 and described at least in paragraph [00149].

Applicant respectfully submits that based at least on the above-cited sections of the specification, one of ordinary skill in the art would indeed be able to precisely identify the associated structure for achieving the specified function within the specification.

Accordingly, Applicant respectfully requests that the rejection under § 112, Paragraph 2 be withdrawn.

### **Claim 27 Recites Statutory Subject Matter Under § 101**

Claim 27 stands rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

Nevertheless, for the sole purpose of expediting allowance, Applicant herein amends claims 27-36 as shown above. For example, claim 27 is amended to recite “one or more computer storage media” in place of the previously presented “processor-readable media.” Support for the amendments to these claims is found in the specification, at least at paragraphs [00154]-[00157], in which “processor-readable media” is defined as including “computer storage media” and the allegedly non-statutory “communication media.” As amended to recite “computer storage media,” Applicant respectfully submits that these claims are no longer directed to the allegedly non-

statutory “communication media,” which, as defined in the specification, is encompassed by the previously presented “processor-readable media.”

Applicant respectfully submits that these amendments render the § 101 rejection moot, and therefore requests that the Office withdrawn the rejection under § 101.

### **Cited Documents**

The following documents have been applied to reject one or more claims of the Application:

- **Vasilevsky:** Vasilevsky, et al., U.S. Patent Application Publication No. 2005/0166258
- **Shteyn:** Shteyn, et al., U.S. Patent No. 6,611,654

### **Claims 27-37 are Non-Obvious Over Vasilevsky in view of Shteyn**

Claims 27-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Vasilevsky in view of Shteyn. Applicant respectfully traverses the rejection.

### **Independent Claims 27 and 37**

Claim 27 recites, in part (emphasis added):

receiving, through the first UI, a user request to send a bookmark to a specified second locus from among the multiple loci, the second locus including a second multimedia presentation system, the bookmark including an indication of a point within a multimedia program;

sending the bookmark to the second multimedia presentation system at the second locus;

**in response to** the second multimedia presentation system **receiving the bookmark, and without user interaction**, presenting a

second UI on the second multimedia presentation system, the second UI prompting for user-selection to resume the multimedia program at the second multimedia presentation system;

Similarly, claim 37 recites, in part (emphasis added):

means for presenting a UI on the first multimedia presentation system, the UI including a display of the bookmark and a prompt for user input to accept the bookmark and resume presentation of the multimedia program at the first multimedia presentation system, the UI being presented **in direct response to receiving the bookmark**, the UI **not being presented in response to user interaction** with the first multimedia presentation system;

Vasilevsky describes a centralized Digital Video Recorder (DVR) and reproduction system that links several reproduction and control units to a centralized media server. *Vasilevsky*, Abstract. The centralized DVR system allows system users to access the same program from different receivers. *Id.* The system further allows users to pause and resume programs from the same marker points (“bookmarks”) established by any system user. *Id.* The media server of Vasilevsky allows a user to place a program bookmark in a program representing a point in the program where reproduction has stopped, and from another reproduction device, resume reproduction of the program from the program bookmark when a user submits a demand for the program. *Id.*, ¶ [0022]. The user submits this demand to the media server via the program guide display presented to the user, wherein the program guide displays previously stored programs on the media server. *Id.*, ¶ [0054].

Shteyn describes a server system that enables subscribers to select a specific broadcast program for recording and a specific location and time frame for play-out of the recorded program. *Shteyn*, Abstract. Shteyn further describes a system that lets a user specify in advance a location for play-out of a specific broadcast or multicast program pre-recorded in response to the user's selection, and has the content made available to the user at that location. *Id.*, c. 1, ll. 55-58. The user specifies where content will be recorded and viewed, not where the program can be resumed from a previously bookmarked location. The user identifies a client device that will record the program, wherein at the appropriate time, the client device then sends a request of the central server for the media stream to be recorded. *Id.*, c. 2, ll. 50-67.

However, neither Vasilevsky nor Shteyn, alone or in combination, teach or suggest, **“in response to the second multimedia presentation system receiving the bookmark, and without user interaction, presenting a second UI on the second multimedia presentation system, the second UI prompting for user-selection to resume the multimedia program at the second multimedia presentation system,”** as recited in claim 27, or **“the UI being presented in direct response to receiving the bookmark, the UI *not* being presented in response to user interaction with the first multimedia presentation system,”** as recited in claim 37. Rather, Vasilevsky describes the user accessing bookmarked content through a programming guide interface, which requires user interaction. Moreover, Shteyn provides no description of how the recorded content is accessed at the remote location.

At most, a combination of Vasilevsky and Shteyn describes a system in which a user can select a specific location like a hotel or bar at which a program is to be recorded. The combination may also allow a user, while viewing a program, to bookmark media content at one client device on a home area network, and then access the bookmarked media content from another client device on the home area network. The purported combination, however, makes no suggestion of specifying a location at which to resume, without user interaction, a program that is already in progress. As discussed above, Shteyn is focused solely on specifying a location at which a program *to be recorded* will be made available to the user.

In contrast, Applicant's claims recite "in response to the second multimedia presentation system receiving the bookmark, and without user interaction, presenting a second UI on the second multimedia presentation system, the second UI prompting for user-selection to resume the multimedia program at the second multimedia presentation system." Neither Vasilevsky nor Shteyn, whether taken alone or in combination, teach or suggest such a second UI, especially such a second UI being presented without user interaction.

For at least the reasons presented herein, the combination of Vasilevsky and Shteyn does not teach or suggest all of the features of claims 27 and 37. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claims 27 and 37.

*The Office Has Not Met Its Burden to Show Obviousness*

A patent applicant is entitled to receive a patent unless the claimed invention is anticipated by or obvious over preexisting references.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in [35 U.S.C.] section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*35 U.S.C. § 103 (a).*

The standard for objective analysis to be applied under 35 U.S.C. § 103 is well settled.

[T]he scope and content of the prior art are . . . determined; differences between the prior art and the claims at issue are . . . ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

*Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

The following analysis illustrates several examples of deficiencies in the reasoning of the Office. For example, given the system described in Vasilevsky, adding a direction to record at a specific location outside of a home area network, as described in Shteyn, does not equate to claims 27 or 37 because such an addition would merely lead to a program being recorded at the specified location. Furthermore, elements described in the references cited by the Office, performing their respective



functions, would not result in the elements and features of claims 27 or 37. Even assuming, arguendo, that each of the elements and features of claims 27 or 37 were found in the cited documents, such elements do not perform the operations claimed and the Office has not identified an objective reason to combine the references. The Office attempts to demonstrate that each of the claim elements were independently known in the prior art to substitute for a proper finding of obviousness. However, it is no more than hindsight to look at the teachings of the cited documents and decide it would be a good idea to, without user interaction, present a second user interface on a second presentation system that prompts for user-selection to resume a multimedia program on the second presentation system. Moreover, the objective reach of claims 27 and 37 do not cover an obvious solution to a known problem.

Furthermore, Applicant submits that, absent hindsight, the Office has not identified a rationale or motivation to combine the teachings of Vasilevsky and Shteyn. The Office Action states, “[i]t would have been obvious for any person of ordinary skill in the art at the time the invention was made to incorporate the teaching of Shteyn in to the system of Vasilevsky for the purpose of allowing users to specify where they want to resume their contents remotely.” *Action*, page 10. However, Vasilevsky describes a system in which, within a home area network, bookmarked content is available from any of the networked devices.

Accordingly, given the system described in Vasilevsky, one of ordinary skill would have no reason to add directing that content be recorded at a specific location such as a hotel or bar outside of the home area network for later playback as discussed in Shteyn.

A person having ordinary skill in the art at the time of the invention would have had no reason to look to Shetyn to solve a problem already solved by Vasilevsky, because Vasilevsky already describes resuming playback at an alternate location.

By virtue of the fact that Vasilevsky recognizes, at least at some level, that being able to access bookmarks at another location is desirable, and Vasilevsky had purportedly solved this problem, a person having ordinary skill in the art presented with Vasilevsky would have had no need to look to the teaching of Shetyn.

In its reasoning, the Board stated: “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning,” (quoting *KSR* at 421; see also *Graham*, at 36). In *Rinkevich*, as in the matter at issue here, the Applicant raised the issue of improper hindsight reasoning. Therein the Board was persuaded that the problem or deficiency that the Office raised as motivation to seek out a secondary reference, “impermissibly used the instant claims as a guide or roadmap in formulating the rejection.” The Board further quoted the Supreme Court in *KSR* stating that “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it,” *KSR*, at 421. Applying common sense to the case at hand, the Board concluded that “a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill,” (emphasis provided). Ultimately the Board found that the Examiner had impermissibly used the claims as a guide to formulate the rejection.

As in *Ex parte Rinkevich*, Applicant submits that a person having ordinary skill in the art would have no reason to combine the teachings of Vasilevsky with Shetyn

because neither reference expresses a reason to combine the teachings of these references, either explicitly or implicitly. The Office suggests that the reason to combine the teaching of Vasilevsky and Shetyn is “for the purpose of allowing users to specify where they want to resume their contents remotely.” *Action*, page 10. However, because Vasilevsky already addresses accessibility of bookmarks at another location, a person of ordinary skill in the art at the time of the invention *having common sense* would not have reasonably looked to Shetyn for such teaching since Vasilevsky had already made the content available from any other available reproduction device. Enabling a user to specify a particular resume location when creating the bookmark would not add functionality to Vasilevsky because, based on the description in Vasilevsky, a pre-specified resume location would not affect the accessibility of the content from any other available reproduction device.

Furthermore, elements described in the references cited by the Office, performing their respective functions, would not result in the elements and features of claims 27 or 37.

The Court has held that a “patent [should not be granted] for a combination which only unites old elements with no change in their respective functions.” *KSR*, at 415-16 (citing *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, (1950)).

As the Court discussed in *KSR*, a patent fails under § 103 when a combination of old elements adds nothing to “the nature and quality” of an already patented device, even when “the combination of old elements perform[s] a useful function.” *KSR*, at 417 (citing *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62 (1950)).

The subject matter of the patent before the Court was a device combining two pre-existing elements: a radiant-heat burner and a paving machine. The device, the Court concluded, did not create some new synergy: The radiant-heat burner functioned just as a burner was expected to function; and the paving machine did the same. The two in combination did no more than they would in separate, sequential operation.

*Id.*

"[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious. *KSR*, at 417 (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

In contrast to facts of the decisions cited in *KSR* and in contrast to *KSR* itself, if the cited previous solutions from Vasilevsky and Shteyn were combined their function would have to change to render the claim obvious. Otherwise, the combination merely describes a system in which a user can select a specific location like a hotel or bar at which a program is to be recorded. The combination may also provide for, while viewing a program, the user can save a bookmark at one client device on a home area network, and then access the bookmark from another client device on the home area network.

Accordingly, Applicant respectfully requests that the Office withdraw the pending § 103 rejections of claims 27 and 37.

### Dependent Claims 28-36

Claims 28-36 each depend from independent claim 27. As discussed above, claim 27 is allowable over the cited documents. Therefore, claims 28-36 are also

allowable over the cited documents of record for at least their dependency from an allowable base claim, and also for the additional features that each recites.

Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claims 28-36.

### New Claims 64-112

New independent claims 64, 76, 79, 80, 86, 88, 93, 101, and 106 are asserted allowable over the cited documents for at least similar reasons as those discussed above. Moreover, these claims are asserted allowable over the cited documents for their own recited features, which the references of record have not been shown to teach or suggest.

New dependent claims 65-75, 77, 78, 81-85, 87, 89-92, 94-100, 102-105, and 107-112 each depend from one of independent claims 64, 76, 80, 86, 88, 93, 101, or 106 and, as such, the remarks made above in regards to claims 64, 76, 80, 86, 88, 93, 101, and 106 apply equally to these claims. These claims are also allowable for their own recited features, which the references of record have not been shown to teach or suggest.

Accordingly, Applicant respectfully asserts that new claims 64-112 are allowable over the cited documents.

## **Conclusion**

For at least the foregoing reasons, all pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application.

If any issues remain that would prevent allowance of this application, **Applicant requests that the Examiner contact the undersigned representative before issuing a subsequent Action.**

Respectfully Submitted,

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